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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,624

04/19/2007

Shunji Suzuki

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38834

7590

01/29/2009

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EXAMINER

HARRIS, GARY D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

01/29/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,624	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> GARY D. HARRIS	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 11/07/2008 have been fully considered but they are not persuasive.

Applicant's arguments regarding process claims are not persuasive. However, in the event that claims directed to the product are found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined. Therefore, rejoinder will be considered upon indication of allowable subject matter pursuant to MPEP 821.04.

Applicant argues that the heat treatment is inseparably connected to the atomic layered unit structure. Examiner agrees with this analysis. However, Yamashita et al. clearly understands that heat treatment will change the magnetization as admitted by applicant (Page 7 in Remarks date 11/7/08). Yamashita clearly understands that interdiffusion occurs in the atomic structure through heat treatment. Examiner interprets a heat treatment to be related to time, temperature and atmospheric conditions. Yamashita clearly understands that the temperatures must be greater than 600 K (327C) and optimally less than 900 K (627) which would overlap applicant's ranges. Yamashita utilizes significantly different atmospheric conditions than applicant and given these differences the product would necessarily be the same as applicants. Unless applicant is willing to supply substantial proof, examiner has no way to distinguish the Yamashita invention would differ from applicants. However, considering that the differences appear to be process related and heat treatment is well known in

Art Unit: 1794

the art, the Supreme Court explained in KSR, “ If a technique has been used to improve one device and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” 127 S. Ct. at 1740. Applicant has not clearly distinguished his claims such that they would necessarily/obviously different than Yamashita.

The rejection is substantially repeated below:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamashita et al. US 7,285,338 (WO 02/15206).

As to Claim 1, Yamashita et al. '338 discloses that the magnetic flux density is determined by the percentage of rare earth material in the film such as R<sub>2</sub>Fe<sub>14</sub>B and further discloses the density can be impacted by manipulating percentages (Col. 5, 6, Line 59-67, 1-4). Examiner interprets the grain diameters, and nucleation type coercive

Art Unit: 1794

force to be an inherent feature as both applicant's and '338 as both look to utilize a heat treated R-T-B magnetic thin film, and both use R2Fe14B. It has been held that where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC §102 or on prima facie obviousness under 35 USC §103, jointly or alternatively. *In re Best, Bolton, and Shaw*, 195 USPQ 430. (CCPA 1977).

As to Claim 2, Yamashita et al. '338 disclose the c-axis of magnetization being randomly orientated (difficult to align) (Col. 1, Line 38-46).

As to Claim 3, Yamashita et al. '338 discloses that the thickness of the thin film is dependent upon the heat treatment given to the alloy (Col. 6, Line 62-67). Additionally, a film thickness of 1 and 1.5 microns are given in table 4.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 1794

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY D. HARRIS whose telephone number is (571)272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary D. Harris/  
Examiner, Art Unit 1794

/Holly Rickman/  
Primary Examiner, Art Unit 1794  
For Gary Harris

Application/Control Number: 10/593,624  
Art Unit: 1794

Page 6